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TECH CENTER 1600/PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Girish V. Shah
SERIAL NO.: 09/251,133
FILING DATE: 17 February 1999
TITLE: NEUROENDOCRINE MARKER
OF PROSTATE CANCER AND
METHOD FOR PRODUCING SAME

EXAMINER: A. Holleran

AU: 1642

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Assist. Commissioner for Patents
Washington, D.C. 20231

**RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS
FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR
AMINO ACID SEQUENCE LISTING DISCLOSURES**

Dear Sir:

The remarks below are provided in response to the Examiner's communication dated October 4, 2000. Attached hereto is a petition for a two month extension of time under 37 C.F.R. § 1.136. Enclosed is a check in the amount of \$195.00, the necessary fee under 37 C.F.R. § 1.17(a)(1) for said two month extension. Applicant considers this response to have been timely filed pursuant to 37 C.F.R. § 1.7 and § 1.8. Payment of this fee, however, is under protest because Applicant did not receive the Examiner's communication until December 5, 2000. The attorney docketed copy of the Examiner's communication is enclosed herewith. Further, Applicant provided the Examiner a "Notice of Change of Address of Attorney of Record" in the response to the Examiner's communication dated June 20, 2000. Therefore, Applicant's request a refund of the fee provided with this response. The Commissioner is hereby authorized to charge any deficiency in fees associated with this communication, or credit any overpayment to Deposit Account No. 19-3140.

In response to the Examiner's communication dated October 4, 2000 requiring Applicant to furnish nucleotide and/or amino acid sequence listing complying with Patent Office standards in the above-referenced application, Applicant encloses herewith a sequence listing in printed and computer readable form. Applicant confirms that the sequence listing provided herewith does not go beyond the disclosure in the international application as filed. Applicant further encloses a copy of the Notice to Comply as requested in the Examiner's communication.

Respectfully submitted,



Joseph A. Mahoney
Reg. No. 38,956

December 19, 2000

SONNENSCHEIN, NATH & ROSENTHAL
8000 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6404
(312) 876-8192

Docket No. 70009590-0015

Application No.: 09/251,133**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
2. This application does not contain, as a separate part of the disclosure on paper copy a "Sequence Listing" as required by 37 C.F.R. 1.821(c). *RECEIVED*
3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e). *JAN 11 2000
TECH CENTER 1600/2900*
4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
7. Other:

Applicant Must Provide:

- An initial or substitute computer readable form (CRF) copy of the "Sequence Listing". 
- An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support (SIRA)

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE

Jill

RAW SEQUENCE LISTING ERROR REPORT



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SEP 25 2000

The Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) detected errors when processing the following computer readable form: TECH CENTER 1600/2900

Application Serial Number: 09/251,133

Source: 1642

Date Processed by STIC: 9/20/2000

THE ATTACHED PRINTOUT EXPLAINS DETECTED ERRORS.

PLEASE FORWARD THIS INFORMATION TO THE APPLICANT BY EITHER:

- RECEIVED JAN 11 2001
- 1) INCLUDING A COPY OF THIS PRINTOUT IN YOUR NEXT COMMUNICATION TO THE APPLICANT, WITH A NOTICE TO COMPLY, or,
 - 2) TELEPHONING APPLICANT AND FAXING A COPY OF THIS PRINTOUT, WITH A NOTICE TO COMPLY

FOR FURTHER INFORMATION, PLEASE TELEPHONE MARK SPENCER,
703-308-4212.

TO REDUCE ERRORED SEQUENCE LISTINGS, PLEASE USE THE CHECKER VERSION 3.0 PROGRAM, ACCESSIBLE THROUGH THE U.S. PATENT AND TRADEMARK OFFICE WEBSITE. SEE BELOW:

Checker Version 3.0

The Checker Version 3.0 application is a state-of-the-art Windows based software program employing a logical and intuitive user-interface to check whether a sequence listing is in compliance with format and content rules. Checker Version 3.0 works for sequence listings generated for the original version of 37 CFR 1.821 – 1.825 effective October 1, 1990 (old rules) and the revised version (new rules) effective July 1, 1998 as well as World Intellectual Property Organization (WIPO) Standard ST.25.

Checker Version 3.0 replaces the previous DOS-based version of Checker, and is Y2K-compliant. Checker allows public users to check sequence listings in Computer Readable form (CRF) before submitting them to the United States Patent and Trademark Office (USPTO). Use of Checker prior to filing the sequence listing is expected to result in fewer cured sequence listings, thus saving time and money.

Checker Version 3.0 can be downloaded from the USPTO website at the following address:
<http://www.uspto.gov/web/offices/pac/checker>

Raw Sequence Listing Error Summary

ERROR DETECTED SUGGESTED CORRECTIONSERIAL NUMBER 09/251,733

ATTN: NEW RULES CASES: PLEASE DISREGARD ENGLISH "ALPHA" HEADERS, WHICH WERE INSERTED BY PTO SOFTWARE

1 Wrapped Nucleic

The number(s) at the end of each line "wrapped" down to the next line.
 This may occur if your file was retrieved in a word processor after creating it.
 Please adjust your right margin to .3, as this will prevent "wrapping".

2 Wrapped Amino

The amino acid number(s) at the end of each line "wrapped" down to the next line.
 This may occur if your file was retrieved in a word processor after creating it.
 Please adjust your right margin to .3, as this will prevent "wrapping".

3 Incorrect Line Length

The rules require that a line not exceed 72 characters in length. This includes space.

4 Misaligned Amino Acid Numbering

The numbering under each 5th amino acid is misaligned. This may be caused by the use of tabs between the numbering. It is recommended to delete any tabs and use spacing between the numbers.

5 Non-ASCII

This file was not saved in ASCII (DOS) text, as required by the Sequence Rules.
 Please ensure your subsequent submission is saved in ASCII text so that it can be processed.

6 Variable Length

Sequence(s) contain n's or Xaa's which represented more than one residue.
 As per the rules, each n or Xaa can only represent a single residue.
 Please present the maximum number of each residue having variable length and indicate in the (b) feature section that some may be missing.

7 PatentIn ver. 2.0 "bug"

A "bug" in PatentIn version 2.0 has caused the <220>-<223> section to be missing from amino acid sequence(s). Normally, PatentIn would automatically generate this section from the previously coded nucleic acid sequences. Please manually copy the relevant <220>-<223> section to the subsequent amino acid sequence. This applies primarily to the mandatory <220>-<223> sections for Artificial or Unknown sequences.

8 Skipped Sequences (OLD RULES)

Sequence(s) missing. If intentional, please use the following format for each skipped sequence:

(2) INFORMATION FOR SEQ ID NO:X:

(i) SEQUENCE CHARACTERISTICS: (Do not insert any headings under "SEQUENCE CHARACTERISTICS")

(ii) SEQUENCE DESCRIPTION: SEQ ID NO:X:

This sequence is intentionally skipped.

Please also adjust the "(a) NUMBER OF SEQUENCES:" response to include the skipped sequence(s).

9 Skipped Sequences (NEW RULES)

Sequence(s) missing. If intentional, please use the following format for each skipped sequence:

<210> sequence id number

<400> sequence id number

000

10 Use of n's or Xaa's (NEW RULES)

Use of n's and/or Xaa's have been detected in the Sequence Listing.

Use of <220> to <223> is MANDATORY if n's or Xaa's are present.

In <220> to <223> section, please explain location of n or Xaa, and which residue n or Xaa represents.

11 Use of <213> Organism (NEW RULES)

Sequence(s) are missing (one mandatory field or its response).

12 Use of <220> Feature (NEW RULES)

Sequence(s) are missing the <220> Feature and associated headings.

Use of <220> to <223> is MANDATORY if <213> ORGANISM is "Artificial" or "Unknown".

Please explain source of genetic material in <220> to <223> section.

(See "Federal Register," 6/01/98, Vol. 63, No. 104, pp. 29631-32) (Sec. 1.829 of new Rules)

13 PatentIn Ver. 2.0 "bug".

Please do not use "Copy to Disk" function of PatentIn version 2.0. This causes a corrupted TIF resulting in missing mandatory numeric identifiers and responses (as indicated on raw sequence listing). Instead, please use "File Manager" or any other means to copy file to floppy disk.

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RAW SEQUENCE LISTING
PATENT APPLICATION: US/09/251,133

DATE: 09/20/2000
TIME: 16:21:27

Input Set : A:\Xnumed15
Output Set: H:\CRF3\09202000\I251133.raw

182 Ser Gln Leu Lys Gly Leu Leu Ser Pro Val Ser Phe Asn His Met Cln
193 20 25 30
194 Asp Ile Pro Gln Arg Tyr Arg Glu Val Asp Cys Ile Phe Phe Leu
195 35 40 45
196 Phe Phe Ser Ser Phe Phe Phe Ser Glu Leu Gly Thr Glu Pro
197 50 55 60
E--> 198 Arg Thr Leu Arg Leu Lys Cys Lys Arg Ser Thr Thr Glu Leu Asn Pro
E--> 199 G 65 70 75 80 85
E--> 200 Gln Pro Arg Leu His Arg Phe Trp Phe Leu Val Lys Phe Arg Gln Ala
E--> 201 66 71 76 81 86 91
E--> 202 67 72 77 82 87 92
E--> 203 68 73 78 83 88 93
E--> 204 69 74 79 84 89 94
E--> 205 70 75 80 85 90 95
E--> 206 71 76 81 86 91 96
E--> 207 Leu Phe Arg Val Pro Phe Val
E--> 208 " " [C]

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messaged
and aid nos.
(see item 4
on Error Summary
sheet)

Please Note:

Use of n and/or Xaa have been detected in the Sequence Listing. Please review the Sequence Listing to ensure that a corresponding explanation is presented in the <220> to <223> fields of each sequence which presents at least one n or Xaa.

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
10/22/00	10/22/00	SHAH	70009590-061

DAVID S ROSENBAUM
SONNIENSCHEIN HANNA & FISCHENTHAL
4000 PINEWOOD DRIVE
CHICAGO, IL 60645-2414

HM22/1094

EXAMINER

MOLLEMAN, A

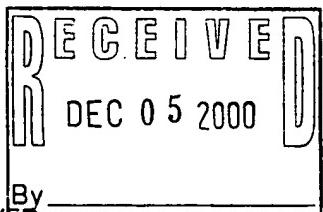
ART UNIT	PAPER NUMBER
1642	9

DATE MAILED: 10/04/00



Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



RECEIVED _____ DOCKET _____
DOCKETED Response
DIARIED 11-4-00
BY [Signature]



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Girish V. Shah
SERIAL NO.: 09/251,133 EXAMINER: A. Holleran
FILING DATE: 17 February 1999 AU: 1642
TITLE: NEUROENDOCRINE MARKER OF PROSTATE
CANCER AND METHOD FOR PRODUCING SAME

Assist. Commissioner for Patents
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this document (along with any being referred to attached and/or enclosed) are being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" Mailing Label No. EM 143 604 465 US on this 1 day of July, 2000 in an envelope addressed to the Assist. Commissioner for Patents, Washington, DC 20231. Sept.

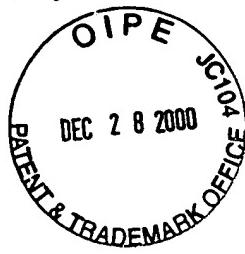
Joseph A. Mahoney
Euri Dunham

**NOTICE OF CHANGE OF ADDRESS OF
ATTORNEY OF RECORD**

Dear Sir:

Please correct your records to reflect a new attorney of record as follows:

Joseph A. Mahoney, Reg. No. 38, 956
SONNENSCHEIN NATH & ROSENTHAL
8000 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6404
(312) 876-3119



PATENT

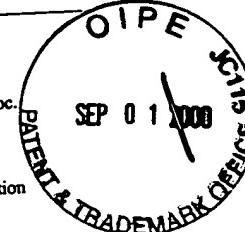
Client No. Ku Medical Center Research Inc. 70009590-0015
Title Diagnostic Marker of Prostate Cancer and Method
Applicant Ginsu V. Shai Filing Date: 2/16/99
Ser.# / Pat.# 09/251,133

Please acknowledge receipt of:

- having _____ pages of specification and claims, and sheets of drawings, FIG(S).
 Declaration / Oath
 Power of Attorney
 Small Entity Statement
 Check # _____
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 Assignment
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 Letter - notice of change of attorney
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 Request for Priority and Pri. Doc.
 Reply to Office Action
 Request for Ext. of Time
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 Amendment After Final Rejection
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 Corrected Drawings
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 Check # _____
 Other _____
 Maintenance Fee Transmittal Form
 Check # _____
 Cert. of Mailing
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By Barbara Balsamo



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